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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Talking Car, Inc.

Serial No. 75/121,820

Jeffrey A. Pine of Baniak Pine & Gannon for Talking Car, Inc.

Glenn G. Clark, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Hanak, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Talking Car, Inc. has filed an application to register the mark TALKING CAR for "information services, namely, providing encoded data pertaining to cars to automobile dealers."[1]

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's services, the term TALKING CAR is merely descriptive of them. Hence, the sole issue before us is whether or not the term TALKING CAR is merely descriptive of applicant's services.

[1] Ser. No. 75/121,820, filed on June 14, 1996, for the services recited above in International Class 39, is based upon an allegation of use in commerce since February 9, 1995.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

We reverse the refusal to register.

By way of background, applicant includes a concise description of its services in its appeal brief (citations omitted):

> Applicant's use of "TALKING CAR" is for information services, i.e., providing encoded data pertaining to cars to automobile dealers. The service is provided when an automobile dealer sends information pertaining to an automobile to Applicant. The Applicant then encodes and electronically stores the data in a cartridge, and returns it to the dealer. The dealer places the cartridge into an Audio Playback Unit (APU) which is placed in the automobile to be sold. When a potential purchaser depresses the start button on the APU, the information is transmitted through the APU. The applicant's information services involve converting the data received from the automobile dealer to a cartridge that is used to audibly transmit the information. Applicant does not sell automobiles, let alone cars that talk.

(Appeal brief, pp. 3-4). In brief, a prospective customer walking through a used car lot any hour of the night or day can hear a spoken message (taken from a text drafted by the dealer) of up to two minutes in length. The prospective customer simply approaches a small, weatherproof digital announcer (having limited reproduction capabilities and quality of sound) that is hanging on the outside of the vehicle's window, and pushes the "play" button.

The Trademark Examining Attorney, on the other hand, maintains that applicant's composite mark is merely descriptive:

> … In the present case, the words comprising the proposed mark are known words which are in common usage in the trade as evidenced by the Lexis-Nexis stories, Web sites of others and third party registrations. The combination of the descriptive words, TALKING and CAR, when considered in relation to the services leaves nothing for speculation or conjecture. No bizarre or incongruous meaning is imparted by the combination of the descriptive words. The combination simply results in a term that is readily understood: a car that talks. As such, the term sought to be registered, TALKING CAR, describes the salient functions, features, uses and purposes of the relevant services.

(Trademark Examining Attorney's appeal brief, p. 9).

Then in its reply brief, applicant highlights the essence of this dispute by responding to the language of the Trademark Examining Attorney's brief quoted above:

> The Examining Attorney's Appeal Brief suffers from the same shortcomings as the previous refusals to register the TALKING CAR mark: it fails to compare the mark at issue to applicant's services. As described in Applicant's opening brief, this is a fatal mistake.
>
> The Examining Attorney sets forth an erroneous presumption: that applicant's services are the equivalent of certain goods, and then compares the mark to the incorrect description of goods. The marks should have been compared to applicant's (amended) information services, in which Applicant provides encoded data to automobile dealers, and not compared to "cars that feature audio communications or means for communicating spoken words" or "a car that talks." This was not done.

(Applicant's reply brief, pp. 1-2).

According to the Trademark Examining Attorney, the record shows that the purchasing public is accustomed to seeing the word "talking" used to describe a variety of inanimate objects (especially those that do not generally have an audio feature)

producing voice-like sounds. Specifically, a series of NEXIS stories used the combined term "talking car" in connection with extant and futuristic automobiles, television commercials and cars featured in television shows or movies. In each excerpt below that the Trademark Examining Attorney extracted from the record for his appeal brief, audio waves of some kind were emanating, or appeared to be emanating, from an automobile:

> " … the process has been widely used, most notably in Nick Perry's Oscar-winning Wallace & Grommet shorts and his series of talking car spots for Chevron." *The Fort Worth Star-Telegram,* (July 10, 1998).
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> "Radio ads set to air next week will feature a talking car (that's right, a talking car) complaining to a mechanic about stop-and-go traffic. The car says it needs a vacation." *Newsday* (New York, NY), (June 20, 1998).
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> "Designed by advertising agency Young & Rubicam, the television commercials debuted in May 1995 and features talking cars with personalities." *San Francisco Business Time* (December 19, 1997).
>
> "One of the highlights of the show was the debut of a prototype 'talking car,' a combined effort of IBM, Sun Microsystems Inc., Devco Electronics and Netscape Communications Corp." *Business Journal- San Jose* (November 24, 1997).
>
> "Clearly, there is a slippery slope principle here: Start out with smart houses and talking cars and computers that act like TVs, and you end up with operatic doorbells. What next? A tea kettle that plays 'I'm a …' " *The Boston Globe*, (March 1, 1998).
>
> "Just when we were getting used to the idea of talking refrigerators and talking cars, along comes the talking urinal." *Star Tribune* (Minneapolis, MN), (April 11, 1998).

Consistent with the last two excerpts above, the Trademark Examining Attorney extracted additional articles from the NEXIS

database showing the word "talking" used more broadly with other goods having an audio communications component.[2] He also supplemented this NEXIS evidence with evidence from specific Web sites demonstrating the use of "Talking" plus the name of various inanimate objects,[3] as well as registrations where third party trademark owners had disclaimed the word "Talking" apart from the composite mark as shown.[4]

As to the second word in this composite mark, the Trademark Examining Attorney says briefly that "the word 'car' describes the subject matter on which the services are used." (Trademark Examining Attorney's appeal brief, p. 5).

In addition, as seen in the quotation above, the Trademark Examining Attorney insists that joining these two individually descriptive words, TALKING and CAR, into the combined term TALKING CAR does not impart any new or incongruous meaning, when used in connection with applicant's services, and that no

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[2] The evidence included references to "talking sign," "talking advertisement," "talking map," "talking greeting cards," "talking cards," "talking dolls," "talking compass," and "talking doorbell."

[3] In addition to repeating some of the terms listed supra from the NEXIS hits, the Web references include "talking car alarm," "talking figures" (i.e., dolls), and "talking toys."

[4] For example, Reg. No. 2,173,870 for TALKING TOTS for "dolls"; Reg. No. 2,005,341 for TALKING DISCOVERY DOODLER for "table top electronic drawing and coloring toy with sound capability"; and Reg. No. 1,330,167 for TALKING BOOKWORM and design for "phonograph records or prerecorded audio tapes and children's books sold as a unit for reading development."

imagination is required to understand the significance of such term in relation to such services.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. *See In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. *See*, *In re Abcor Development Corp.*, *supra* at 218, and *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. *See In re Atavio*, 25 USPQ2d 1361 (TTAB 1992) and *In re TMS Corp. of the Americas*, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. *See In re George Weston Ltd.*, 228 USPQ 57, 58 (TTAB 1985).

Although perhaps a close question, in the present case we are constrained to agree with applicant that the term TALKING CAR is suggestive rather than merely descriptive of its services. While applicant's services ultimately may be said to permit a used car sitting out on the used car lot to "talk" to the prospective customer, the term TALKING CAR does not immediately, and without conjecture or speculation, indicate the

purpose or function of applicant's services or forthwith convey, with the requisite particularity, a significant feature or other aspect of the services.

Applicant contends, and we agree, that we must consider this mark as applied to these services. As seen in the recital, these are information services directed to used car dealers – not to the customer or prospective customer of the used automobile.[5] Unlike the analogies the Trademark Examining Attorney has drawn to uses taken from NEXIS, Web and third-party uses, the instant case does not involve a mark for the named goods.

For example, in reviewing the evidence of record, "Talking car alarm" (*see* footnote 3 *supra*) would have to be considered highly descriptive, if not generic, for an automobile alarm having a sensor that triggers a voice module. Similarly, "Talking doll" is obviously generic for an entire category of toy dolls. In fact, in most of the examples in the record where the word "talking" is modifying a noun, it is being used in reference to goods, not services. In the rare example of a service mark having such a construction (e.g., "TALKING ADS and design" for telemarketing services), the service involved is

[5] In fact, there is no reason to assume that the prospective customer of a used car would even be apprised of the involved service mark when confronted with the audio playback unit.

actually telephone *advertising* – the very term (in its shortened form) being modified within the expression.

Similarly, applicant seems to concede that if one is referring to goods in the nature of an automobile or auto component having an electronic speech module or something else akin to a talking voice, then "talking car" may well directly and immediately describes a significant function of such goods. The NEXIS examples placed into the record by the Trademark Examining Attorney reflect a variety of ways in which this term may well be used descriptively – whether it be a reference to a well-known car in a movie, a TV series, or a clever television ads, or used in connection with state-of-the-art vehicle telematics. Hence, the record does show sufficiently broad usage of this combined term as applied to automobiles, that if the goods herein were cars or car components, we would probably find this term to be merely descriptive. That is, we agree with the Trademark Examining Attorney that even though most cars are still not known to provide information about themselves by emitting speech, we find that the composite mark, TALKING CAR, no longer contains the requisite element of incongruity as applied to a car which in fact "talks," as to avoid the label of "merely descriptive."

Where applicant and the Trademark Examining Attorney disagree is whether this matter remains merely descriptive under

the Lanham Act when the same term is applied to applicant's services – services that ultimately do enable a used car to provide information, in a talking voice, to potential purchasers. The Trademark Examining Attorney takes the arguable position that a significant feature of applicant's services is the information about the car that this recited service enables the digital play-back unit attached to the window of a used car to impart to potential purchasers of the used car, by "talking."

Here we agree with applicant that some imagination is required to connect applicant's chosen mark with the benefits applicant offers. *Cf*. *Golden Door, Inc. v. Odisho*, 646 F.2d 347, 208 USPQ 638 (9th Cir. 1980) [GOLDEN DOOR is suggestive of health and beauty spa]; *West & Company, Inc. v. Arica Institute, Inc*., 557 F.2d 338, 195 USPQ 466 (2nd Cir. 1977) [While the word PSYCHOCALISTHENICS suggests a number of things about physical exercises, it does not describe any one thing in particular, and hence is suggestive]; *In re HUNT, d.b.a. The Fontaine Organization*, 132 USPQ 564 (TTAB 1962) [MARRIAGE PROPONENTS suggestive for prospective marriage partner services inasmuch as applicant itself does not make marriage proposals]; *In re Aid Laboratories, Inc*., 221 USPQ 1215, 1216 (TTAB 1983) [PEST PRUF merely suggests a possible end result of the use of animal shampoo having insecticide properties]; *In re Frank J. Curran Co*., 189 USPQ 560 (TTAB 1975) [CLOTHES FRESH suggestive of an

end result of the use of spray deodorant product for clothes]; and *In re C. J. Webb, Inc.*, 182 USPQ 63, 64 (TTAB 1974) [BRAKLEEN is suggestive of a desired result of a brake cleaner]. In the instant case, making this connection will involve a multistage reasoning process, even on the part of relatively knowledgeable and sophisticated purchasers. Accordingly, we find that the term TALKING CAR is, at best, suggestive of the end result of the use of applicant's services rather than merely descriptive of its services.

However, to the extent that there may be any doubt as to our conclusion, we resolve such doubt, in accordance with the Board's practice, in favor of the publication of applicant's mark for opposition. *See In re Aid Laboratories, Incorporated*, *supra*; *In re Conductive Systems, Inc.*, 220 USPQ 84, 86 (TTAB 1983); *In re Morton-Norwich Products*, Inc., 209 USPQ 791 (TTAB 1981); and *In re Gourmet Bakers*, Inc., 173 USPQ 565 (TTAB 1972).

Decision: The refusal under Section 2(e)(1) is reversed.